

REMARKS

Claims 11-28 are pending. Claims 1-10 are currently canceled. Claims 11, 12 and 19 are currently amended. Reconsideration of the application is requested.

§ 103 Rejections

Claims 11 and 26 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Masaki et al. (JP 10-077308 Machine Translation provided by Examiner) in view of Akihiro et al. (JP H2000-230162A1 Machine Translation provided by Examiner) substantially as set forth in the office action notification dated 6/25/2008. Regarding claim 11, Examiner has pointed out that for the purpose of searching for and applying prior art under 35 USC 102 or 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, the recitation “consisting essentially of” will be construed as equivalent to “comprising.” (MPEP 2111.03).

Examiner further states that claim 11 recites "a pressure-sensitive adhesive having an acrylic polymer containing units derived from a mixture consisting essentially of". The open language "having" does not preclude the PSA that further includes filler particles of flame-retardant composition of Masaki and that substitution of the phrase "consisting essentially of" for the term "having" will be consistent with arguments made by the applicant in Office Action dated 6/25/2008.

The Applicants have amended claim 11 to substitute the phrase “consisting essentially of” for the term “having” as suggested by the Examiner on page 10 of the Office Action of November 24, 2008. The Applicants submit that with the amendment described above, amended claim 11 is now in condition for allowance for at least the following reason. The retardant composition of Masaki contains either one of (i) fibrous filler, (ii) porous fine particles, (iii) non-polar resin fine particles, and (iv) organic fine particles. (see [57] abstract). The purpose of the invention of Masaki is to provide an adhesive tape with high fire retardancy, and high shear strength and peel strength (see [0005]). The means of solving the problem is to incorporate a filler (see [0006]). The specification of Masaki suggests in many places (paragraphs [0019] – [0028]) that the purpose of adding the filler(s) is to increase shear strength of the adhesive. The Applicant contends that the purpose of the filler is to change the characteristics (i.e., shear

strength and adhesion) of the pressure sensitive adhesive and thus Masaki et al is excluded by the recitation of “consisting essentially of”. As a result, Masaki is not proper prior art for rejection of Applicant’s claim 11. Since the purpose of the filler in Masaki’s invention is to change the characteristic (e.g. increase shear strength) of the adhesive, claim 11 as currently amended excludes Masaki reference and is patentable. Akihiro is mute with respect to this argument.

Claim 26 adds additional features to claim 11. Claim 11 is patentable for the reasons given above. Thus, claim 26 is likewise patentable.

In summary, the rejection of claims 11 and 26 under 35 USC § 103(a) as being unpatentable over Masaki in view of Akihiro has been overcome and should be withdrawn.

Claims 11-28 stand rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Moon et al. (US 4,988,742) in view of Blance et al. (US 3,632,412) and Akihiro et al. (JP H2000-230162 Machine Translation). It is the Examiner’s position that Moon discloses an acrylic terpolymer PSA and PSA tapes comprising acrylic terpolymer PSA. And, furthermore, the Examiner states that Moon “discloses a multilayer tape construction wherein coatable composition (i.e. PSA adhesive) are coated to provide a plurality of superimposed layers.”

The Applicants have amended claims 11, 12, and 19. Amended claim 11 recites that the claimed invention “comprises a pressure-sensitive adhesive consisting essentially of an acyclic polymer ...” (emphasis added). As noted by the Examiner in paragraph 37 of the non-final office action of November 24, 2008, Moon contemplates that the adhesion strength of the PSA is materially altered by the addition of the tackifying agents as shown in Table II (col. 11, lines 1-9 of Moon). Amended claim 12 and 19 recite “a first pressure sensitive adhesive having two sides and consisting essentially of”, which exclude a PSA that further includes a tackifier. (emphasis added) Thus, currently amended claims 12 and 19 exclude Moon as prior art and are, thus, patentable. Blance and Akihiro do not change the argument.

Claims 13-18 and 27 ultimately depend upon and add additional features to amended claim 12. Claim 12 is patentable for the reasons given above. Thus, claims 13-18 and 27 are likewise patentable.

Claims 20-26 and 28 ultimately depend upon and add additional features to amended claim 19. Claim 19 is patentable for the reasons given above. Thus, claims 20-25 and 28 are likewise patentable.

In summary, the rejection of claims 11-28 under 35 USC § 103(a) as being unpatentable over Moon in view of Blance and Akihio has been overcome and should be withdrawn.

Telephonic interview

Applicants wish to thank the Examiner for the interview held on February 6, 2009, attended by Anish Desai (Examiner), Steve Wolf (Agent) and Sundar Rajan (Agent) during which the merits of the case were discussed.

An interview summary by the Examiner, dated February 12, 2009 has been received and is believed to be accurate except that the Applicants have pointed out to the Examiner that pages 4-5 of the specification traverse the statement by the Examiner in paragraph 31 of the Office Action of November 24, 2008 that "...nothing in the specification of the present invention discloses or fairly suggests that the shear strength is basically the novel characteristic[s] of the present invention."

In view of the above, it is submitted that the application is in condition for allowance.

Examination and reconsideration of the application as amended is requested.

Respectfully submitted,

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